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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,836	04/02/2004	Christian Galea	119339	8842
25944	7590	02/14/2007	EXAMINER	
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			DOUYON, LORNA M	
			ART UNIT	PAPER NUMBER
			1751	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/14/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/815,836	GALEA, CHRISTIAN	
	Examiner	Art Unit	
	Lorna M. Douyon	1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 04 December 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 25-28 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-24 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____. |

1. This action is responsive to the amendment filed on December 04, 2006.
2. Claims 1-28 are pending. Claim 28 is newly added.
3. The rejection of claims 18, 21, 22, 25-27 under 35 U.S.C. 112, second paragraph is withdrawn in view of Applicant's amendment.
4. The rejection of claims 25-27 under 35 U.S.C. 101 is withdrawn in view of Applicant's amendment.
5. The rejections of claim 25 under 35 U.S.C. 103(a) as being unpatentable over each of Olson et.al. (US Patent No. 6,472,027), Takayanagi et al. (US Patent No. 5,612,303), and over Lallier et al. (US Patent No. 6,656,896) in view of Olson or Takayanagi are withdrawn in view of Applicant's amendment.
6. Amended claims 25-27 and newly added claim 28 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:
 - I. Claims 1-24 are drawn to a stripping composition, classified in class 510, subclass 201;
 - II. Claims 25-28 are drawn to a method for stripping, classified in class 134, subclass 38.

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The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the process for using the product as claimed can be practiced with another materially different product such as a water-based mixture of one or more high boiling, high flash aromatic solvent(s), a peroxide generating agent, and a hydroxycarboxylic acid.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, **claims 25-28 are withdrawn from consideration** as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

7. Claims 1 and 23 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Olson et al. (US Patent No. 6,472,027) for the reasons set forth in the previous office action.

8. Claims 1-6 and 17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Takayanagi et al. (US Patent No. 5,612,303) for the reasons set forth in the previous office action.

9. Claims 1-22 and 24 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Lallier et al. (US Patent No. 6,656,896), hereinafter "Lallier" in view of Olson or Takayanagi for the reasons set forth in the previous office action.

Response to Arguments

10. Applicant's arguments filed December 4, 2006 have been fully considered but they are not persuasive.

With respect to the rejection based upon Olson, Applicant argues that nowhere does Olson teach or suggest a stripping composition having, as an active ingredient, at least benzyl acetate, and a solvent chosen from methoxypropyl acetate, diacetone alcohol, methyl ethyl ketone, isophorone and the mixture of these as recited in claim 1. Applicant also argues that Olson merely teaches a stripping composition intended to remove a UV curable floor finish from a floor, the composition comprising a polar solvent, one (among many) of which may be benzyl acetate, and an optional less dense

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polar solvent that may include (among many) diacetone acetate, isophorone and methyl ethyl ketone (se col. 1, lines 60-65). Applicant also argues that Olson teaches a stripping composition that is aqueous, containing at least 80% water and being inhomogeneous (col. 7, lines 41-52 and abstract) whereas the claimed stripping composition must be devoid of water.

The Examiner respectfully disagrees with the above arguments because in col. 3, line 54, Olson teaches that a stripper composition contains a polar solvent, and teaches as one preferred dense polar solvent, benzyl acetate in col. 3, line 59. Olson also teaches, in col. 4, lines 1-16, that less dense polar solvents can be used alone or in combination with one or more other polar solvents, and the less dense polar solvents include diacetone alcohol (lines 5-6), isophorone (line 14) and methyl ethyl ketone (line 16). This teaching suggests the combination of benzyl acetate with at least diacetone alcohol, isophorone and methyl ethyl ketone. In col. 4, lines 56-59, Olson teaches that another useful subclass of stripper composition contains a blend of primary solvent and one or more ether alcohol solvent couplers in the substantial absence of water. In col. 7, lines 6-9, Olson also teaches that the stripper composition usually will be packaged as a concentrate intended to be mixed with water or another suitable solvent...prior to use.

With respect to the rejection based upon Takayanagi, Applicant argues that nowhere does Takayanagi teach or suggest a stripping composition having, as an active ingredient, at least benzyl acetate, and a solvent chosen from methoxypropyl acetate, diacetone alcohol, methyl ethyl ketone, isophorone and the mixture of these as recited in claim 1, and their recited amounts. Applicant also argues that Takayanagi

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merely teaches a solvent composition for use as a solvent in paints, varnishes, coatings, adhesives and printing inks (col. 1, lines 81-12). Applicant also argues that there is nothing in Takayanagi that the separate components of claim 1 should be selected for use together.

The Examiner respectfully disagrees with the above arguments because in col. 4, lines 36-38, Takayanagi teaches that the solvent composition is also useful as a resist stripper. In col. 9, line 52 to col. 10, line 24, Takayanagi also teaches that the solvents which are particularly useful to provide a resist stripper includes methyl ethyl ketone (col. 9, lines 64-65), benzyl acetate (col. 10, line 6), propylene glycol monomethyl ether acetate (equivalent to methoxypropyl acetate) (col. 10, lines 13-14) which are used in combination of two or more thereof. In col. 5, lines 43-53, Takayanagi teaches that the proportion of oxyisobutyric esters in the composition is preferably not less than 5% or 10% by weight, hence, the remainder of the composition would be the solvents. Table 17 under cols 24-25 discloses various ratios of oxyisobutyric esters with various solvents.

With respect to the rejection based upon Lallier in view of Olson or Takayanagi, Applicant argues that none of Lallier, Olson and Takayanagi, taken singly or in combination, teaches or suggests a stripping composition having, as active ingredient, at least benzyl acetate, and a solvent chosen from methoxypropyl acetate, diacetone alcohol, methyl ethyl ketone, isophorone and the mixture of these as recited in claim 1. Applicant argues that Lallier teaches a first generation stripping composition suitable for stripping external organic coatings, such as exterior waterproof coatings and thin films,

and that nothing in Olson or Takayanagi would have led one of ordinary skill in the art to select benzyl acetate from these compositions for use in Lallier.

The Examiner respectfully disagrees with the above argument because each of Lallier, Olson and Takayanagi teaches analogous art of stripping compositions, hence, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate benzyl acetate into the stripper composition of Lallier because Lallier specifically desires at least one cosolvent, and Olson or Takayanagi teaches benzyl acetate as one useful solvent for stripper composition which solvent, when added, would provide additive effect to the stripping composition. It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose, see *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980).

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lorna M. Douyon whose telephone number is 571-272-1313. The examiner can normally be reached on Mondays-Fridays 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on 571-272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Lorna M. Douyon
LORNA M. DOUYON
PRIMARY EXAMINER